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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/540,890

02/23/2006

Zvika Gilad

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EXAMINER

CANDLER, SAMUEL M

ART UNIT

PAPER NUMBER

3739

MAIL DATE

DELIVERY MODE

01/19/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/540,890	Applicant(s) GILAD ET AL.	
	Examiner SAMUEL CANDLER	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5,7-21 and 23-38 is/are pending in the application.
- 4a) Of the above claim(s) 14,15,27 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5, 7-10, 12, 16-21, 23-24, 26 and 29-38 is/are rejected.
- 7) ☒ Claim(s) 11,13 and 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/08/09, 11/06/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This office action is responsive to the amendment filed on 10/1/09. As directed by the amendment: claims 1, 3, 5, 7, 17, 22 and 33-35 have been amended, and claims 2, 4, 6 and 21 have been cancelled. Claims 1, 3, 5, 7-13, 16-20, 22-26 and 29-38 are presently examined in the application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3, 5, 7-9, 12, 16-20, 22-23, 26 and 29-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Imran et al (U.S. Patent No. 6,535,764).

4. Re claims 1, 17, 22-23, 29-31 and 33-35, Imran et al discloses an autonomous in vivo sensing device 110 (see Figure 1) comprising a sensor (see col. 11 lines 23-39; not shown) and a degradable immobilizer 263 (via tip 270; see col. 17 lines 7-29; Figures 27 A&B), said sensing device to collect data relating to changes in in-vivo environmental conditions, said sensing device to transmit said data, and said immobilizer capable of being activated in response to said signal (see col. 11 lines 23-39 and col. 22 line 57 –

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col. 23 line 32), wherein said signal is issued in response to an environmental condition related to said data.

5. Re claims 3 and 18, Imran et al discloses wherein the device collects data within a body lumen and a processor external to the device issues said signal (data relating to the condition of the stomach is relayed to processor/display 498 which notifies the user to activate the immobilizer; see col. 22 line 31 - col. 23 line 5; Figures 35 A&B).

6. Re claim 5, Imran et al discloses wherein said immobilizer is capable of degrading upon exposure to in vivo conditions (see col. 17 lines 24-29).

7. Re claims 7, 20, 32 and 36, Imran et al discloses wherein said sensor can comprise an imager (see col. 10 lines 44-49 and col. 22 line 60 – col. 23 line 5).

8. Re claims 8, 9, 19 and 37, Imran et al discloses wherein said immobilizer comprises a pointed anchor 270 (see col. 17 lines 24-29; Figures 27 A&B).

9. Re claims 12 and 26, Imran et al discloses wherein said immobilizer comprises a composition delivery unit 271 (see col. 17 lines 30-61; Figures 27 A&B).

10. Re claim 16, Imran et al discloses a power source (see col. 5 lines 49-57).

11. Re claim 38, Imran et al discloses a transmitter 45 (see col. 14 lines 21-24; Figure 25).

12. Claims 1, 5, 7-10, 16-17, 19-20, 22, 24, 32-33 and 35-38, are rejected under 35 U.S.C. 102(e) as being anticipated by Kilcoyne et al (U.S. Patent No. 6,689,056).

13. Re claims 1, 7, 17, 20, 22, 32-33 and 35-36, Kilcoyne et al discloses an autonomous in vivo sensing device 18, 160 (see col. 9 lines 29-42 and col. 17 lines 57-58; Figure 6) comprising a sensor (imager within 160; see col. 13 lines 46-48 and col.

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17 lines 57-58) and a degradable immobilizer (clip - not shown; see col. 9 lines 55-66), said sensing device to collect data relating to changes in an in vivo environmental conditions, said sensing device to transmit said data, and said immobilizer capable of being activated in response to a signal, wherein said signal is issued in response to an environmental condition related to said data (operator views a desirable area to be operated on and deploys the immobilizer).

14. Re claim 5, Kilcoyne et al discloses wherein said immobilizer is capable of degrading upon exposure to in vivo conditions (see col. 9 lines 61-63).

15. Re claims 8, 9, 19 and 37, Kilcoyne et al discloses wherein said immobilizer comprises a pointed anchor (see col. 9 lines 49-54).

16. Re claims 10 and 24, Kilcoyne et al discloses wherein said immobilizer comprises a spring (see col. 9 lines 55-61).

17. Re claim 16, Kilcoyne et al discloses a power source 114 (see col. 7 lines 39-43; Figure 2).

18. Re claim 38, Kilcoyne et al discloses a transmitter 112 (see col. 7 lines 39-45; Figure 2).

Response to Arguments

19. Applicant's arguments with respect to claims 1, 3, 5, 7-13, 16-20, 22-26 and 29-38 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

20. Claims 11, 13 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following reference discloses medical devices which anchor to an in vivo site:

U.S. PGPub 2003/0167024

U.S. Patent No. 7,509,174

U.S. Patent No. 7,107,100

U.S. Patent No. 6,285,897

U.S. Patent No. 7,076,305

22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAMUEL CANDLER whose telephone number is (571)270-3410. The examiner can normally be reached on Monday - Friday, 8 a.m. - 5 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SAMUEL CANDLER/
Examiner, Art Unit 3739

/John P Leubecker/
Primary Examiner, AU 3739